UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/890,498	07/31/2001	Haruo Togashi	450106-02874	4795

20999 7590 04/20/2006

FROMMER LAWRENCE & HAUG
745 FIFTH AVENUE- 10TH FL.
NEW YORK, NY 10151

EXAMINER	
DUNN, MISHAWN N	

ART UNIT	PAPER NUMBER
2621	

DATE MAILED: 04/20/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

	Application No.	Applicant(s)	
Office Action Summary	09/890,498	TOGASHI ET AL.	
	Examiner	**Art Unit**	
	Mishawn N. Dunn	2621	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *31 July 2001*.

2a)☒ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1,3-5 and 7-18* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1,5 and 9-18* is/are rejected.

7)☒ Claim(s) *3,4,7, and 8* is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *30 March 2006* is/are: a)☒ accepted or b)☒ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☒ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Response to Arguments

1. The Examiner withdrawals the objection to Figures 1A-1E of the drawings based on Applicant's amendment to add the legend "Related Art."

2. The double patenting rejection is still pending, as a Terminal Disclaimer was not submitted with the amendment filed on 03/30/2006.

3. Applicant's arguments filed 03/30/2006 have been fully considered but they are not persuasive.

Applicant argues that the interpolating feature is not disclosed or suggesting in the teachings of Yoneyama.

In response the Examiner respectfully disagrees. It is noted that interpolating can be interpreted as inserting between other things or parts. Therefore Yoneyama discloses interpolating the header of the highest hierarchical level, as recited in claim 1, in col. 3, lines 28-33, wherein the sequence header is inserted at the beginning of each sequence.

Claim Objections

4. Claim 4 is objected to because of the following informalities: Line 2 should read, "**the** bit stream..." Appropriate correction is required.

5. Claim 9 is objected to because of the following informalities: Line 2 should read, "video signal, generating bit stream having a hierarchical structure composed **of** a plurality..." Appropriate correction is required.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., In re Berg, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); In re Goodman, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); In re Longi, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); In re Van Ornum, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); In re Vogel, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and In re Thorington, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

6. Claims 1 and 17 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-3 of copending Application No. 09/890497. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims of the instant application are substantially the same as that of the copending application.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

7. Application claims 1 and 17, respectively, recite all as recited in copending application claims 1-3. While the claims in '498 are not identical to the claims in '497,

the scope of the '498 claims are encompassed by the '497 claims, and could have been submitted in that application. Hence, the obviousness double patenting rejection is deemed appropriate.

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

9. Claims 1, 5, and 9-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yoneyama (US Pat. No. 5,701,386) in view of Kosugi (US Pat. No. 6,426,771).

10. Consider claims 1 and 13. Yoneyama teaches a recording apparatus (col. 3, lines 9-12; fig. 1) and reproducing apparatus (col.4, lines 40-42; fig. 3) for compression-encoding a digital video signal, generating a bit stream having a hierarchical structure composed of a plurality of hierarchical levels (col. 4, lines 13-14, fig. 2B), and recording the bit stream to a record medium (col. 4, lines 20-21) comprising: adding means for adding a header of the highest hierarchical level to the bit stream of each frame (col. 3, lines 28-33; fig. 2B); interpolating (inserting) means for interpolating (inserting) the header of the highest hierarchical level (col. 3, lines 28-33; fig. 2B); and recording means for recording the bit stream to which the header of the highest hierarchical level has been added to the record medium (col. 4, lines 20-21).

Yoneyama does not disclose an encoding means for intra-frame encoding all the digital video signal. However, Kosugi teaches encoding means for intraframe encoding all the digital video signal so as to compress the digital video signal (col. 3, lines 53-55; fig. 1). An artisan with ordinary skill in the art would readily recognize that before MPEG, a variety of JPEG methods were used to create consecutive frames. JPEG does not use interframe coding between frames and is easy to edit, but not as highly compressed as MPEG. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Yoneyama by utilizing JPEG compression to intraframe encode the entire digital signal in order to provide enhanced quality.

11. Consider claims 5 and 16. Yoneyama teaches a recording apparatus (col. 3, lines 9-12; fig. 1) and reproducing apparatus (col.4, lines 40-42; fig. 3) for compression-encoding a digital video signal, generating a bit stream having a hierarchical structure composed of a plurality of hierarchical levels (col. 4, lines 13-14, fig. 2B), and recording the bit stream to a record medium (col. 4, lines 20-21), comprising: adding means for adding a quantizing matrix to the bit stream of each frame (col. 3, lines 28-33; fig. 2B); interpolating (inserting) means for interpolating (inserting) the header of the highest hierarchical level (col. 3, lines 28-33; fig. 2B); and recording means for recording the bit stream to which the quantizing matrix has been added to the record medium (col. 3, lines 28-29).

Yoneyama does not disclose an encoding means for intra-frame encoding all the digital video signal. However, Kosugi teaches encoding means for intraframe encoding all the digital video signal so as to compress the digital video signal (col. 3, lines 53-55;

fig. 1). An artisan with ordinary skill in the art would readily recognize that before MPEG, a variety of JPEG methods were used to create consecutive frames. JPEG does not use interframe coding between frames and is easy to edit, but not as highly compressed as MPEG. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Yoneyama by utilizing JPEG compression to intraframe encode the entire digital signal in order to provide enhanced quality.

Consider claims 17 and 18. Yoneyama does not specifically teach a tape shaped record medium, Yoneyama discloses disc-type record medium (col. 4, lines 20-21). An artisan with ordinary skill in the art would readily recognize that any recording medium could be used as long as video data can be recorded.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to use, to modify the recording apparatus of Yoneyama by utilizing a tape record medium in order to be more cost efficient.

12. Method and apparatus claims 9-12, 14, 15, and 18 are rejected using similar reasoning as the corresponding apparatus claims above.

Allowable Subject Matter

13. Claims 3, 4, 7, and 8 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mishawn N. Dunn whose telephone number is 571-272-7635. The examiner can normally be reached on Monday - Friday 7:30 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thai Tran can be reached on 571-272-7382. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Mishawn Dunn
April 16, 2006